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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/537,371	06/03/2005	Katsuhiko Kumakura	043888-0378	2638
20277	7590	07/11/2006		
MCDERMOTT WILL & EMERY LLP 600 13TH STREET, N.W. WASHINGTON, DC 20005-3096			EXAMINER CHEN, VIVIAN	
			ART UNIT	PAPER NUMBER

1773

DATE MAILED: 07/11/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/537,371

Applicant(s)

KUMAKURA ET AL.

Examiner

Vivian Chen

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-9 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-9 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 03 June 2005 is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. ____.
 - ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date ____.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. ____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: ____.

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DETAILED ACTION

Double Patenting

1. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the “right to exclude” granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

2. Claims 1-9 are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over:

claims 1-18 of copending Application No. 10/555,172 (US 2006/0108978);

Although the conflicting claims are not identical, they are not patentably distinct from each other because the copending Application claims a battery package comprising the recited laminate base sheet with printing, the recited container portion, and the recited plurality of batteries encased in the recited shrink wrap film.

This is a provisional obviousness-type double patenting rejection.

Claim Rejections - 35 USC § 103

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. Claims 1-9 are rejected under 35 U.S.C. 103(a) as being unpatentable over:

EUROPEAN PATENT APPLICATION 0 742 160 (EP '160) or JAPANESE PATENT APPLICATION 09-221170 (JP '170);

in view of FIRST TO DEVELOP BLISTER PACK... "BIODEGRADABLE PLASTIC" (hereinafter MITSUSHITA NEWS RELEASE);

and in view of OYA ET AL (US 6,153,276).

EP '160 and JP '170 both disclose conventional battery packaging comprising a base sheet, a container portion, and plurality of batteries encased in shrink wrap film. However, the references do not explicitly disclose the use of biodegradable aliphatic polyesters. (entire documents)

MITSUSHITA NEW RELEASE discloses that it is well known in the art to utilize biodegradable materials such as polylactic acid polymers to form the components of battery packaging materials.

OYA ET AL discloses a biodegradable polylactic acid-based laminate film, wherein the film comprises a polylactic acid-based base layer, an adhesive layer, and a polylactic acid surface

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layer, wherein the surface layer has a typical thickness of 1-30 microns, the laminate has an typical overall thickness up to 5-3000 microns and wherein the laminate is typically oriented and is suitable for a wide variety of packaging material components (e.g., cases, containers, trays, blister backs, etc.)

It would have been obvious to a person of ordinary skill in the art at the time the invention was made to utilize the biodegradable laminate of OYA ET AL to form the backing sheet component and container component of the battery package of EP '160 and JP '170. One of ordinary skill in the art would have utilized a biodegradable adhesive (claim 4) in the laminate of OYA ET AL in order to facilitate the compostability of the packaging. It would have been obvious to situate a conventional functional layers such as a print layer between the base layer and the adhesive layer (claim 1) in order to protect the printing and/or to provide a tamper detection function. One of ordinary skill in the art would have utilized known biodegradable materials such as polylactic acid films for the shrink wrap component of the battery package (claims 7-9) to maintain the biodegradable nature of the packaging.

3. Claim 7-9 are rejected under 35 U.S.C. 103(a) as being unpatentable over:

EUROPEAN PATENT APPLICATION 0 742 160 (EP '160) or JAPANESE PATENT APPLICATION 09-221170 (JP '170);

in view of FIRST TO DEVELOP BLISTER PACK... "BIODEGRADABLE PLASTIC" (hereinafter MITSUSHITA NEWS RELEASE); and in view of OYA ET AL (US 6,153,276);

as applied to claim 1 above,

and further in view of TERADA ET AL (US 2002/0052445).

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TERADA ET AL '445 discloses that it is well known in the art to use oriented polylactic acid-based films as shrink films for packaging applications. (paragraph 11, 28-29)

It would have been obvious to a person of ordinary skill in the art at the time the invention was made to use a known biodegradable film as the shrink wrap component of the packaging of JP '170 or EP '160 to maintain the overall biodegradable nature of the packaging.

Conclusion

4. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Vivian Chen whose telephone number is (571) 272-1506. The examiner can normally be reached on Monday through Thursday from 8:30 AM to 6 PM. The examiner can also be reached on alternate Fridays.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Carol Chaney, can be reached on (571) 272-1284. The fax phone number for the organization where this application or proceeding is assigned is (571) 273-8300.

The General Information telephone number for Technology Center 1700 is (571) 272-1700.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

June 23, 2006



Vivian Chen
Primary Examiner
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